

Mail Stop Appeal Brief – Patents

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Patent Application of Charles Eldering et al.

Conf. No.: 8882 : Group Art Unit: 2424
Appln. No.: 09/712,790 : Examiner: SHELEHEDA, James R.
Filing Date: 14 NOVEMBER 2000 : Attorney Docket No.: T721-10
Title: Queue Based Advertisement Scheduling and Sales

APPELLANT'S REPLY BRIEF TO THE EXAMINER'S ANSWER

In response to the Examiner's Answer dated September 9, 2009, and further to the Appeal Brief filed June 16, 2009, Applicant hereby submits a Reply Brief in accordance with 37 C.F.R. §41.41 for the above-referenced application.

A Request for Oral Hearing under 37 C.F.R. §41.47 is submitted herewith.

This Reply Brief is being filed in response to the Examiner's Answer, dated September 9, 2009 (Examiner's Answer). All of the arguments set forth in the Appellant's Appeal Brief, filed June 16, 2009 (Appeal Brief), are incorporated herein by reference.

RESPONSE TO EXAMINER'S ARGUMENTS

With respect to the Examiner's "Response to Argument" set forth at pages 28 – 36 of the Examiner's Answer, Applicants respectfully submit that the Examiner continues to misconstrue the teachings of U.S. Patent No. 6,698,020 to Zigmund *et al* ("Zigmund") and U.S. Patent Application Publication No. 2003/0200128 to Doherty ("Doherty") and their combination.

Combination of References

The Examiner continues to assert that Applicants have argued against the obviousness rejection by attacking the references individually. *Examiner's Answer at 28*. The Examiner cites *In re Keller*, stating, "one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references." While an accurate quotation, *Keller* continues that a reference in a 35 U.S.C. § 103 rejection, "would have suggested to one of ordinary skill in the art," to make the invention. Here, the Examiner has been unable to articulate why two references (i.e., Zigmund and Doherty), which admittedly do not alone teach the claimed element(s), would have suggested the claimed element(s). It is not enough to simply state that a combination teaches something with nothing except for a vague conclusion. Furthermore, MPEP 2145 also relies on *In re Merck & Co.*, 800 F.2d 1091 (Fed. Cir. 1986). *Merck* supports the contention that one cannot attack references individually, but concludes that, "[T]hus, Petersen must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole." Therefore, the teachings of both references are important, and the combined teaching is paramount. If the combination does not teach a claimed element, the 103 rejection is improper.

Accordingly, in arguments pertaining to particular features of Zigmond and Doherty (either individually or in combination), Applicants have pointed out that such references do not teach or suggest certain features as contended by the Examiner which the Examiner explicitly or implicitly relies on for purposes of asserting the combination. If such features are not present in a particular reference as contended by the Examiner, or a particular feature is not present in a reference which renders the reference's teaching(s) irrelevant or improperly applied to the claimed subject matter, a distinction with respect to that reference is entirely proper.

Furthermore, the Federal Circuit has more recently ruled that, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (U.S. 2007), quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). As such, there must be an articulated reason that two references teach a given claim element and not just a "mere conclusory statement." Here, the Examiner admits that the prior art references do not individually teach, "selling specific queue slots," and fails to articulate a reason why the combination teaches this feature.

Combination of Zigmond and Doherty Does Not Teach or Suggest "selling specific queue slots"

As previously explained, neither Zigmond nor Doherty teaches or suggests, "selling specific queue slots," as recited in the independent claims. *Appeal Brief at 13 – 16*. Neither of the applied references teaches or suggests the concept of selling specific slots generally or in a queue. The Examiner admits as much, stating that, "[n]either Zigmond nor Doherty were individually relied upon to disclose this limitation, as it is taught by the combination of the two references." *Examiner's Answer at 28*. The Examiner argues that, "the *combination* of Zigmond and Doherty would clearly provide for creating a queue of ad slots (ad schedule taught by Doherty), where an advertiser is

sold a specific queue slot (as the advertiser can decide when their ad is displayed relative to another ad, see Zigmond as column 14, lines 13-24). *Id.* at 29 (emphasis in original). Beyond the fact that Applicants strenuously disagree with the Examiner’s interpretation of the above-noted teachings of the references, Applicants also disagree with the Examiner’s unfounded conclusion that the combination of Zigmond and Doherty teaches the claimed elements.

More specifically, the Examiner argues that, “while the claims recite ‘selling specific queue slots’, there are no requirements as to how the slots are selected/sold to advertisers.” *Id.* at 29. However, the fallacy in the Examiner’s argument is that the claimed feature speaks for itself. That is, independent claim 1 recites, “selling specific queue slots...” It does not matter how the “buyer” of the slots determines whether (or not) to purchase such a slot. What matters is that “specific slots” are sold.

Furthermore, the Examiner contends that because the combination results in advertisers paying to have their ad included in the schedule, “every individual slot within the schedule has been sold....By having their ads set into specific positions within the schedule, the advertisers have been sold those specific slots.” *Id.* at 29 – 30.

However, the argument set forth by the Examiner highlights what appears to be a fundamental misunderstanding in the Examiner’s interpretation of the claim language: “selling specific queue slots” is not equivalent to “assigning” slots or including an ad for display as implied by the Examiner, merely because an advertiser made a payment in exchange for display of his ad. The prior art, at best, teaches selling a “general slot” to an advertiser. However, a general slot is not a “specific slot” as claimed. Stated differently, in the prior art, the advertiser is quite intentionally not sold a specific slot. This is because the advertiser wants to have its ad displayed generally and/or because the advertisement system (e.g., Zigmond, Doherty) assigns the advertiser to a particular slot. In either case, there is no sale of a specific slot. Moreover, Applicants respectfully submit that the elements of the claim have meaning as recited, and must be interpreted as such. The Examiner would like to misconstrue the claim to read, “selling slots in a queue that have advertisements designated at specific locations,” contending that the

combination of Zigmond and Doherty meets the language. However, the claims actually recite, "selling specific queue slots," which is not rendered obvious by the prior art. *See Appeal Brief* at 16.

In addition, as discussed at pages 15 – 16 of the Appeal Brief, it cannot be inferred from a combination of Zigmond and Doherty – nor would it have been obvious to one skilled in the art – that specific slots would be sold at all, let alone specific slots in the included schedule or queue. Accordingly, Applicants respectfully submit that the combination of Zigmond and Doherty does not result in all features of the claims.

Conclusion

In view of the foregoing, as well as the reasons set forth in the Appeal Brief, Applicants respectfully submit that the Examiner has not met the burden of *prima facie* obviousness to support the rejection of claims 1 – 10, 12 – 18, 60, 62 – 65 and 68 – 105. Accordingly, for the reasons detailed herein and in the Appeal Brief, independent claims 1, 60, 79 and 97, and all claims dependent thereon, including claims 2 – 10, 12 – 18, 62 – 65, 68 – 78, 80 – 96 and 98 – 105, are allowable over the combination of Zigmond and Doherty. Applicant respectfully requests that the Board reverse the Examiner's rejections of the claims and remand this application for issue.

Respectfully submitted,

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